

Appln. No.: 10/017,382
Amendment dated April 8, 2005
Reply to Office Action of January 21, 2005

REMARKS/ARGUMENTS

The Office Action of January 21, 2005, has been carefully reviewed and these remarks are responsive thereto. No amendments are made in the present response. Reconsideration and allowance of the instant application are respectfully requested.

Allowed Subject Matter

Claim 2 is objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form, including the limitations of any intervening claims. Applicants have not amended claim 2 at this time, based on the arguments in favor of allowability of the rejected base claim as set forth below.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-20 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson *et al.* (U.S. 2002/0004424, hereinafter Nelson) in view of Newman *et al.* (U.S. 2002/0133562, hereinafter Newman). This rejection is respectfully traversed for at least the following reasons.

No Motivation to Combine the References

The Office Action indicates that it would have been obvious to combine Nelson and Newman "in order to facilitate interaction play between the players." However, this is not a motivation to combine the references, but is the end-result of the combination *taught by Applicant's own disclosure*. That is, *the combination was made only made after the Office benefited from reading Applicant's own application* to learn that such a combination was desirable. There is no suggestion or motivation identified in the Office Action to combine the references, and thus the combination is the result of impermissible hindsight reasoning.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office

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Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure, as would be required in order to make such a combination.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that there would have been no motivation or suggestion to combine Nelson with Newman at the time of the claimed invention, and that the Office Action does not establish a *prima facie* case of obviousness.

The References do not Teach or Suggest All the Claim Limitations

Even if Nelson were somehow combined with Newman, the combination does not teach or suggest all the limitations of any claim.

For example, claim 1 recites a mobile terminal "forwarding the task for delivery to a second mobile terminal." The Office Action correctly indicates that Nelson does not disclose forwarding the task to a second mobile terminal. The Office Action goes on to argue, however, that Nelson describes a task passing function, and that Newman suggests transmitting the task to other player terminals. The implication is that the combination therefore describes forwarding the task for delivery to a second mobile terminal.

However, neither reference teaches or suggests forwarding the task for delivery to a second mobile terminal. The alleged "passing function" of Nelson, as it is referred to by the Office Action, is actually a function to *skip* a question altogether, not pass an action to another player. That is, the Nelson reference uses the word "pass" to indicate that a question is skipped. Nelson states "by pressing the 'pass' button, a player advances to the next question without being required to answer the current question..." Nelson at [0065]. The examiner is attempting to change the meaning of the word "pass" in Nelson to apparently mean "send to another player," which is improper and inconsistent with Nelson's teachings. There is simply no teaching or implication in Nelson that a task can be forwarded from one player to another, as recited in claim 1.

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Newman, also, does not teach or suggest such a feature. At paragraph 48 (the paragraph cited by the Office Action), Newman describes a user submitting a question or comment to a technical director for delivery to a host or producer. However, this is not the same as forwarding a task to a second mobile terminal, as claimed. The question or comment is submitted by the user to the host or producer, not to another mobile terminal. In addition, the question or comment is not a task that could have been responded to by the first mobile terminal, as claimed. Thus, claim 1 is allowable even if Nelson and Newman had somehow been combined.

Independent claims 14 and 46 are allowable for similar to reasons to claim 1. In addition, with respect to claim 46, the host or producer to which a comment or question is submitted in Newman is not another player, as claimed. The host or producer is the provider of an event, and claim 46 is therefore also allowable for this additional reason.

Dependent claims 2-13 and 15-20 are allowable for at least the same reasons as their respective base claims, and further in view of the additional features recited therein.

For example, with respect to claim 3, Newman merely describes a chat feature, which is not the same as "when the first player selects forwarding the task for delivery to a second mobile terminal, said player input comprises an identity of a second player," as claimed.

With respect to claims 8 and 20, neither Nelson nor Newman teach or suggest that a task response includes audio and/or video recorded by the mobile terminal, as claimed. Indeed, the Office Action does not even attempt to cite a portion of Newman or Nelson teaching such a feature.

With respect to claims 9-11, 16 and 17, selecting a player that has not already received the task, is on the same team, or that is registered with the task server is more than a mere design choice, as a determination must be made in each scenario to confirm that a receiving player matches the claimed characteristics.

Applicants therefore respectfully request that the rejection of claims 1, 3-20 and 46 be withdrawn.

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CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and solicit prompt notification of the same. However, if for any reason the examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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Dated this 8th day of April, 2005

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